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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/977,306  | 10/16/2001  | Shinichi Yada        | 110870              | 4668             |
| 25944   | 7590        | 11/07/2005           | EXAMINER            |                  |
| OLIFF & BERRIDGE, PLC<br>P.O. BOX 19928<br>ALEXANDRIA, VA 22320 |             |                      | WOO, ISAAC M        |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2166                |                  |
| DATE MAILED: 11/07/2005   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                |  |
|------------------------------|-------------------------------|--------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>09/977,306 | Applicant(s)<br>YADA, SHINICHI |  |
|                              | Examiner<br>Isaac M. Woo      | Art Unit<br>2166               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 23-27 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 31, 2005 has been entered.

2. Claims 1-3 and 29-30 are amended. Claims 23-27 and 31 are withdrawn. Claims 1-22 and 28-30 presented for examination for this office action.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-22 and 28-30 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106 (II) (A):

*A. Identify and Understand Any Practical Application Asserted for the Invention*

*The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600,1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.*

*Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.*

Regarding claims 1-3, the claim limitation of claims 1-3, "An electronic information management server for classification and retrieval of documents", raise a

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question as to whether the claimed invention is directed merely to an abstract idea that is not tied to a producing a concrete, useful, and tangible result to from the basis of statutory subject matter under 35 U.S. C. § 101. Claims 1-3 include *no physical structure of the machine in terms of its hardware or hardware and software combination*. Because the limitation of claims 1-3, every “means for” is computer program software system that are not embedded any a computer-readable medium and run by any a computer or machine. Therefore, the claims are not a statutory system and should be rejected under 35 U.S. C. § 101 as not being tangible.

Regarding claims 12, 13, 28 and 30, “An electronic information management method”, can be implemented without computer or machine. Because the limitation of claims 12, 13, 28 and 30, “storing”, “extracting”, “deciding” and “accepting”, can be implemented by a human with a pencil, and a piece of paper for tracking a configuration of an asset. Thus, the languages of claims 12, 13, 28 and 30 raise a question as to whether the claimed method is directed merely to an abstract idea that is not tied to a producing a concrete, useful, and tangible result to from the basis of statutory subject matter under 35 U.S. C. § 101. Therefore, the claimed invention is non-statutory subject matter. The claims should be amended to indicate that the subject matter is implemented by a computer, i.e., a computer implemented method.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-22 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas Huston et al (U.S. Pub. No. 2002/0007402, hereinafter, "Huston") in view of David (U.S. Patent No. 6,801,902).

With respect to claim 1, Huston discloses, extracting (retrieving) a feature based on an instruction from a client (102, user, fig.1, page 1, section [0011], user requests for electronic document retrieval, page 10, section [0091]), the feature associated with electronic information stored in storing means (112, 114, and 116, content provider, fig.1, page sections [0097-0010]) connected to a network, (internet, fig. 1); deciding whether the electronic information is to be deleted based on the feature extracted by the feature extracting means and on a condition specified by the client, see (page 3, section [0037]); and deleting from the storing means via the network unnecessary electronic information decided to be deleted by the deciding means, see (page 4, section [0040-0043], page 6, sections [0053-0054], user request to delete contents). Huston does not explicitly disclose, extracted feature is at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents an

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application name under which the document is created, a document keyword and a full text of the document. However, David discloses, the automatically generated contents of the extended index features can be extracted from the documents as well. Such extracted contents of the index features are, for example the name of the author, the title or an abstract of the document, a text of a document present in the facsimile format detected by optical character recognition (OCR), or an invoice number detected by means of bar code recognition. But it is also possible to automatically extracted the entire text from any desired document and to file such text in a data bank with full-text capability. This teaches that the system extracts the entire text that includes at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents an application name under which the document is created, a document keyword and a full text of the document. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify by incorporating extracted feature is at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents an application name under which the document is created, a document keyword and a full text of the document. Thus, one having ordinary skill in the art at the time the invention was made would have been motivated to use such a modification because that would provide Huston's system the enhanced extracting data feature method in the data retrieval and management system.

With respect to claims 2-3, Huston discloses, storing means connected to a network for storing electronic information, see (112, 114, and 116, content provider, fig.1, page sections [0097-0010]); extracting (retrieving) a feature based on an instruction from a client (102, user, fig.1, page 1, section [0011], user requests for electronic document retrieval, page 10, section [0091]), the feature associated with electronic information stored in storing means (112, 114, and 116, content provider, fig.1, page sections [0097-0010]) connected to a network, (internet, fig. 1); deciding whether the electronic information is to be deleted based on the feature extracted by the feature extracting means and on a condition specified by the client, see (page 3, section [0037]); and deleting from the storing means via the network unnecessary electronic information decided to be deleted by the deciding means, see (page 4, section [0040-0043], page 6, sections [0053-0054], user request to delete contents). Huston does not explicitly disclose, extracted feature is at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents an application name under which the document is created, a document keyword and a full text of the document. However, David discloses, the automatically generated contents of the extended index features can be extracted from the documents as well. Such extracted contents of the index features are, for example the name of the author, the title or an abstract of the document, a text of a document present in the facsimile format detected by optical character recognition (OCR), or an invoice number detected by means of bar code recognition. But it is also possible to automatically extracted the entire text from any desired document and to file such text in a data bank with full-text



capability. This teaches that the system extracts the entire text that includes at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents an application name under which the document is created, a document keyword and a full text of the document. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify by incorporating extracted feature is at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents an application name under which the document is created, a document keyword and a full text of the document. Thus, one having ordinary skill in the art at the time the invention was made would have been motivated to use such a modification because that would provide Huston's system the enhanced extracting data feature method in the data retrieval and management system.

With respect to claim 4, Huston discloses, whether the electronic information is to be deleted based on a feature comprising a character string, see (page 4, section [0040-0043], page 6, sections [0053-0054], user request to delete contents includes text).

With respect to claim 5, Huston discloses, whether the electronic information is to be deleted based on a feature comprising an image, see (page 4, section [0040-0043], page 6, sections [0053-0054], user request to delete web contents includes images).

With respect to claim 6, Huston discloses, whether the electronic information is to be deleted based on a feature comprising a similar image, see (page 4, section [0040-0043], page 6, sections [0053-0054]).

With respect to claim 7, Huston discloses, decides that other electronic information related to specific electronic information is also deleted together with the specific electronic information decided to be deleted based on the feature, see (page 4, section [0040-0043], page 6, sections [0053-0054]).

With respect to claim 8, Huston discloses, temporarily storing electronic information sent via a network, deletes the unnecessary electronic information stored in the temporarily storing means at a predetermined timing, see (page 4, section [0040-0043], page 6, sections [0053-0054]).

With respect to claim 9, Huston discloses, deletes the unnecessary electronic information from the temporarily storing means after a predetermined period of time has elapsed, see (page 4, section [0040-0043], page 6, sections [0053-0054]).

With respect to claim 10, Huston discloses, instructing a feature associated with the electronic information to be deleted, see (page 4, section [0040-0043]).

With respect to claim 11, Huston discloses, inputting the feature and transferring it to the instructing and operating means, see (page 4, section [0040-0043]).

With respect to claim 12, Huston discloses, storing predetermined electronic information, see (112, 114, and 116, content provider, fig.1, page sections [0097-0010]); extracting (retrieving) a feature associated with electronic information stored in storing means (112, 114, and 116, content provider, fig.1, page sections [0097-0010]) connected to a network, (internet, fig. 1); deciding whether the electronic information is to be deleted from a previously extracted feature based on a condition specified by the client, see (page 3, section [0037]); and deleting from the storing means via the network unnecessary electronic information decided to be deleted by the deciding means, see (page 4, section [0040-0043], page 6, sections [0053-0054], user request to delete contents). Huston does not explicitly disclose, extracted feature is at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents an application name under which the document is created, a document keyword and a full text of the document. However, David discloses, the automatically generated contents of the extended index features can be extracted from the documents as well. Such extracted contents of the index features are, for example the name of the author, the title or an abstract of the document, a text of a document present in the facsimile format detected by optical character recognition (OCR), or an invoice number detected by means of bar code recognition. But it is also possible to automatically extracted the entire text from any desired document and to file such text in

a data bank with full-text capability. This teaches that the system extracts the entire text that includes at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents an application name under which the document is created, a document keyword and a full text of the document.

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify by incorporating extracted feature is at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents an application name under which the document is created, a document keyword and a full text of the document. Thus, one having ordinary skill in the art at the time the invention was made would have been motivated to use such a modification because that would provide Huston's system the enhanced extracting data feature method in the data retrieval and management system.

With respect to claim 13, Huston discloses, extracting (retrieving) a feature associated with electronic information stored in storing means (112, 114, and 116, content provider, fig.1, page sections [0097-0010]) connected to a network, (internet, fig. 1); deciding whether the electronic information is to be deleted from a previously extracted feature based on a condition specified by the client, see (page 3, section [0037]); and deleting from the storing means via the network unnecessary electronic information decided to be deleted by the deciding means, see (page 4, section [0040-0043], page 6, sections [0053-0054], user request to delete contents). Huston does not explicitly disclose, extracted feature is at least one of a title of a documents a creation

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date of the document, a creator of the document, a file name of the documents an application name under which the document is created, a document keyword and a full text of the document. However, David discloses, the automatically generated contents of the extended index features can be extracted from the documents as well. Such extracted contents of the index features are, for example the name of the author, the title or an abstract of the document, a text of a document present in the facsimile format detected by optical character recognition (OCR), or an invoice number detected by means of bar code recognition. But it is also possible to automatically extracted the entire text from any desired document and to file such text in a data bank with full-text capability. This teaches that the system extracts the entire text that includes at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents an application name under which the document is created, a document keyword and a full text of the document. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify by incorporating extracted feature is at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents an application name under which the document is created, a document keyword and a full text of the document. Thus, one having ordinary skill in the art at the time the invention was made would have been motivated to use such a modification because that would provide Huston's system the enhanced extracting data feature method in the data retrieval and management system.

With respect to claim 14, Huston discloses, whether the electronic information is to be deleted based on a feature comprising a character string, see (page 4, section [0040-0043], page 6, sections [0053-0054], user request to delete contents includes text).

With respect to claim 15, Huston discloses, whether the electronic information is to be deleted based on a feature comprising an image, see (page 4, section [0040-0043], page 6, sections [0053-0054], user request to delete web contents includes images).

With respect to claim 16, Huston discloses, whether the electronic information is to be deleted based on a feature comprising a similar image, see (page 4, section [0040-0043], page 6, sections [0053-0054]).

With respect to claim 17, Huston discloses, decides that other electronic information related to specific electronic information is also deleted together with the specific electronic information decided to be deleted based on the feature, see (page 4, section [0040-0043], page 6, sections [0053-0054]).

With respect to claim 18, Huston discloses, temporarily storing electronic information sent via a network, deletes the unnecessary electronic information stored in

the temporarily storing means at a predetermined timing, see (page 4, section [0040-0043], page 6, sections [0053-0054]).

With respect to claim 19, Huston discloses, deletes the unnecessary electronic information from the temporarily storing means after a predetermined period of time has elapsed, see (page 4, section [0040-0043], page 6, sections [0053-0054]).

With respect to claim 20, Huston discloses, instructing a feature associated with the electronic information to be deleted, see (page 4, section [0040-0043]).

With respect to claim 21, Huston discloses, inputting the feature and transferring it to the instructing and operating means, see (page 4, section [0040-0043]).

With respect to claim 22, Huston discloses, inputting a feature associated with the electronic information to be deleted; and giving a deletion execution instruction to unnecessary electronic information that is to be deleted and extracted from the storing means according to the input feature, see (page 4, section [0040-0043], page 6, sections [0053-0054]).

With respect to claim 28, Huston discloses, extracting (retrieving) a feature associated with electronic information stored in storing means (112, 114, and 116, content provider, fig.1, page sections [0097-0010]) connected to a network, (internet,

fig. 1); deciding whether the electronic information is to be deleted from a previously extracted feature based on a condition specified by the client, see (page 3, section [0037]); and deleting from the storing means via the network unnecessary electronic information decided to be deleted by the deciding means, see (page 4, section [0040-0043], page 6, sections [0053-0054], user request to delete contents). Huston does not explicitly disclose, extracted feature is at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents an application name under which the document is created, a document keyword and a full text of the document. However, David discloses, the automatically generated contents of the extended index features can be extracted from the documents as well. Such extracted contents of the index features are, for example the name of the author, the title or an abstract of the document, a text of a document present in the facsimile format detected by optical character recognition (OCR), or an invoice number detected by means of bar code recognition. But it is also possible to automatically extracted the entire text from any desired document and to file such text in a data bank with full-text capability. This teaches that the system extracts the entire text that includes at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents an application name under which the document is created, a document keyword and a full text of the document. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify by incorporating extracted feature is at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents



an application name under which the document is created, a document keyword and a full text of the document. Thus, one having ordinary skill in the art at the time the invention was made would have been motivated to use such a modification because that would provide Huston's system the enhanced extracting data feature method in the data retrieval and management system

With respect to claim 29, Huston discloses, storing electronic information sent via a network in temporary storing means; and deleting unnecessary electronic information stored in the temporary storing means at a predetermined timing, see (page 4, section [0040-0043], page 6, sections [0053-0054]).

With respect to claim 30, Huston discloses, accepting a condition from a client, see (page 3, section [0037], user request to delete contents); accepting feature associated with electronic information stored in storing means (112, 114, and 116, content provider, fig.1, page sections [0097-0010]) connected to a network, (internet, fig. 1); accepting a deletion execution instruction for unnecessary electronic information that is to be deleted extracted from the storing means according to accepted features and to the accepted condition, see (page 4, section [0040-0043], page 6, sections [0053-0054], user request to delete contents). Huston does not explicitly disclose, extracted feature is at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents an application name under which the document is created, a document keyword and a full text of the

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document. However, David discloses, the automatically generated contents of the extended index features can be extracted from the documents as well. Such extracted contents of the index features are, for example the name of the author, the title or an abstract of the document, a text of a document present in the facsimile format detected by optical character recognition (OCR), or an invoice number detected by means of bar code recognition. But it is also possible to automatically extracted the entire text from any desired document and to file such text in a data bank with full-text capability. This teaches that the system extracts the entire text that includes at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents an application name under which the document is created, a document keyword and a full text of the document. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify by incorporating extracted feature is at least one of a title of a documents a creation date of the document, a creator of the document, a file name of the documents an application name under which the document is created, a document keyword and a full text of the document. Thus, one having ordinary skill in the art at the time the invention was made would have been motivated to use such a modification because that would provide Huston's system the enhanced extracting data feature method in the data retrieval and management system

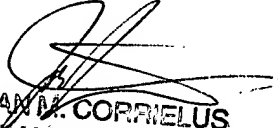
***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M. Woo whose telephone number is (571) 272-4043. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IMW  
October 28, 2005

  
JEAN M. CORNELIUS  
PRIMARY EXAMINER